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PATENT APPLICATION
MO-6509
LeA 34,279

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION OF |) | |
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| CHRISTOPH SCHWEMLER ET AL |) | GROUP ART UNIT: 1732 |
| |) | |
| SERIAL NUMBER: 09/933,360 |) | EXAMINER: |
| |) | MONICA ANNE HUSON |
| FILED: AUGUST 20, 2001 |) | |
| |) | |
| TITLE: PROCESS FOR PRODUCING |) | |
| POLYCARBONATE AND |) | |
| PRODUCTS THEREFROM |) | |

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner's Answer dated January 11, 2006 has been reviewed and compels the following response:

The rejection of Claims 1, 4 and 5 alleges anticipation by Woldenberg.

The claims at issue are directed to a process that require polycarbonate in molten state be introduced directly from production into an injection molding machine to form a shaped product, the process excluding the conventional intermediate step of granulation.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an enveloped addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 February 23, 2006
Date

Aron Preis, Reg. No. 29426
Name of applicant, assignee or Registered Representative

Signature
February 23, 2006
Date

Woldenberg disclosed making a foamed polycarbonate, the essence of the invention being the specific alumina foaming agent. In this context Woldenberg describes a process entailing adding conventional additives to polycarbonate and after such addition mixing it with the foaming agent followed by injection molding to produce a foamed article; no granulation is at all mentioned.

(i) Based on Woldenberg's silence in respect to granulation the Examiner concludes that granulation, a conventional step, has been deliberately omitted. Woldenberg is in effect relied upon for what it does not teach or at best for what it discloses by implication.

A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Nothing in the statute or case law recognizes "anticipation by implication".

(ii) The law has long recognized that "which would literally infringe if later in time anticipates if earlier." *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003). Appellants submit that if the activity as described by Woldenberg were practiced after the patenting of the present invention as presently claimed, the activity without more would not amount to infringement since it does not clearly exclude a claimed feature.

(iii) According to Woldenberg the mixing of polycarbonate, foaming agent conventional additives and other thermoplasts and/or impact strength modifiers, may be carried out at room temperature in known manner (col. 6, lines 18-22). Curiously, the Examiner reads the permissible "may" in reference to mixing at "room temperature" as expressed or inherent, disclosure of mixing at the much higher melt temperature of polycarbonate.

Appellants are not certain why or how this reading fits within the context of a rejection sounding in anticipation and submit it does not.

(iv) The Examiner's argument that room temperature can be broadly interpreted to be any temperature at which a room is maintained cannot rationally be taken to refer to the melt temperature of polycarbonate (240 - 300°C). The term "room temperature" is a term-of-art and was shown in the course of prosecution to have a dictionary definition of 20 to 25°C. Examiner's position in this connection is simply not credible. To the contrary, the art-skilled would rather reasonably be expected to draw from the Woldenberg (col. 6, lines 18 - 23) that granulation or pelletizing has to be carried out before mixing, since mixing polycarbonates with other individual components at or near room temperature requires the resin to be in a form enabling mixing. That is to say that the polycarbonate needs to be in granulated or pelletized form in order to be mixed with the other components at a temperature.

Consideration of this Reply along with the Appeal Brief is requested.

Respectfully submitted,

By



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